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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,311	10/30/2001	Jeffery O. Burrell	60027.0051US01	7213

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EXAMINER

O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,311

Applicant(s)

Burrell et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 30, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-14 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Moreover, current Office practice is to reject as non-statutory under § 101, method claims such as claims 1-14 that fail to require the use of any particular technology (e.g., a computer) for failing to fall within the technological arts, thus failing to produce a useful, concrete, and tangible result. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as a computer *per se* or some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)¹ the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-6 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by the admitted prior art, as described in the background section of the specification on pages 1 and 2.

The admitted prior art includes all of the elements of claims 1-6 and 14 because the claims read merely on the known manual method of maintaining an inventory record for inventory having various locations and performing a periodic manual inventory update to correct/reconcile any discrepancies in the inventory record as the accuracy of the record

¹ The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

diminishes over time. Note that all claimed features are either explicitly described by the admitted prior art, or else would necessarily, thus inherently, be performed in practicing the method described by the admitted prior art. Note too, that the invention, *as claimed*, requires no computer or other apparatus whatsoever to be performed, the claims reading merely on the recited steps being performed manually.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-13 and 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the background section of the specification on pages 1 and 2.

The admitted prior art describes a method of reconciling a current central inventory record having counts and location assignments for a plurality of product types, as applied above in the rejection of claims 1 and 6 under 35 U.S.C. 102(a), but the admitted prior art fails to include the steps of removing outlier values from the data; averaging the remaining data values; and, using the calculated average as the adjustment amount when the current inventory data needs to be updated/adjusted/corrected due to a discrepancy in the count of items, as determined

by an updated inventory assessment, rather than simply using the oldest/earliest value and using that value without regard as to whether or not the value was obviously erroneous.

However, FIFO, LIFO, average, and weighted average are four well known, hence obvious, techniques to use in the valuation of inventory. Furthermore, excluding obviously erroneous, mis-keyed data to improve the accuracy of results when averaging data is also a well known, hence obvious, technique to use when calculating a statistical average.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method described in the admitted prior art, so as to periodically perform necessary corrections/adjustments/updates to inventory based on inventory valuation calculated on an average basis, rather than a FIFO basis, as is well known to do, and to exclude clearly erroneous, mis-keyed data when calculating the average, as is also well-known to do, in order to produce an accounting of inventory that would be as accurate as possible, and since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 8, 9, 12, and 13, the further details of these dependent claims would all be either inherent in the described combination, or else self-evident or well known, hence obvious, to one of ordinary skill in the art, such that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have made any necessary modifications, merely as a matter of design choice, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 10 and 11, the admitted prior art does not include making substitutions of inventory for interchangeable parts to offset a surplus of one with a shortage of another, based on a substitution table to indicate interchangeability of parts. However, storing a list of interchangeable parts in a table and making substitutions of interchangeable parts to offset a shortage of one with a surplus of another is a well known, hence obvious, technique to employ in performing an accounting of inventory. For example, if 60 Energizer AA batteries and 40 Duracell AA batteries are later determined to instead be 60 Duracells and 40 Energizers, there are still 100 AA batteries. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of the admitted prior art so as to provide a substitution table of interchangeable parts and make substitutions of interchangeable parts to offset a shortage of one with a surplus of another, as is well known to do, in order to minimize the amount of adjustments being made to correct the inventory, thereby improving the accuracy, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 15-26, drawn to apparatus for performing, in an automated fashion, the methods/functions of claims 1-14, the admitted prior art does not include that any known apparatus is capable of performing, in an automated fashion, the methods described by the admitted prior art. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided apparatus such as recited by claims 15-26, since the underlying method steps/functions being performed by the apparatus are themselves either

known or considered obvious, as set forth in the rejections of claims 1-14 hereinabove, and because it has been held that broadly providing a mechanical or automatic means to replace manual activity which would accomplish the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to the disclosure.
8. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

December 13, 2004

 (12-13-04)

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627